

Appl. No. 10/730,438  
Docket No. CM2713Q  
Amdt. dated August 25, 2008  
Reply to Office Action mailed on April 23, 2008  
Customer No. 27752

## REMARKS

### Claim Status

Claims 1 - 11 are pending in the present application.

Claim 1 is amended herein. Support for the amendment is found at page 9, lines 1-7 of the specification.

In addition, new Claims 10 and 11 have been added. Support for these new claims is found at page 14, lines 25-27, and page 15, lines 1-6 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Applicants thank the Examiner for the courtesy of the telephonic interview with the undersigned scheduled and conducted August 20, 2008. Applicants believe that the interview served to clarify the matters discussed.

### Rejection under 35 USC §103(a) over Noda et al. in view of Yeo et al.

Claims 1 and 2 stand rejected under 35 USC §103(a) as being unpatentable over Noda et al., USPN 6,949,689, in view of Yeo et al., USPN 5,695,855. Applicants respectfully traverse the rejection.

Under MPEP §2142, the Office bears the burden of factually supporting an asserted *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537; 218 U.S.P.Q. 871 (Fed. Cir. 1983). If the Office does not demonstrate *prima facie* unpatentability, then without more, the applicant is entitled to the grant of the patent. *See In re Oetiker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

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To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. *See, e.g., CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342; 68 U.S.P.Q.2d 1940 (Fed. Cir. 2003).

Without conceding the correctness of the rejection, Applicants have amended independent Claim 1. Amended Claim 1 recites a disposable article selected from baby diapers, pull-on diapers, pants or adult incontinence diapers comprising a liquid pervious topsheet, a liquid impervious backsheet and an absorbent core positioned between said topsheet and said backsheet, wherein said backsheet comprises at least one polymeric film and at least one nonwoven web, wherein said polymeric film and said nonwoven web each have two major surfaces, said polymeric film comprises a polymeric film material, and said nonwoven web comprises a polymeric nonwoven web material, wherein at least one of said polymeric film material or said polymeric nonwoven web material is color-pigmented by one or more pigments mixed therein prior to formation of said polymeric film or said nonwoven web, and wherein at least one of said polymeric film or said nonwoven web has visually discernible printed ornamental designs, said printed ornamental designs being provided by printing a pigmented ink onto at least one of said major surfaces of at least one of said polymeric film or said nonwoven web, and said polymeric film being joined in an overlaying region across at least part of one of its major surfaces to at least part of an adjacent major surface of said nonwoven web to form said backsheet, and wherein said backsheet in said overlaying region has an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an “a” value for red/green-appearance from about -50.0 to about +50.0 and a “b” value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed ornamental designs. By dependency, Claim 2 contains all of the elements of Claim 1.

Applicants respectfully submit that neither Noda et al. nor Yeo et al., alone or in combination, teaches or suggests a disposable article as recited. Without waiving, and reserving, all other arguments Applicants may have, the references in combination do not disclose a backsheet comprising at least one polymeric film and at least one nonwoven web, wherein at least one of the polymeric film material or the polymeric nonwoven web material is color-pigmented by one or more pigments mixed therein prior to formation of said polymeric film or said nonwoven web, wherein the backsheet has an L Hunter value from 10 to 75, in the areas outside printed ornamental designs.

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As noted by the Office at page 3 of the Office Action dated 4/23/08, Noda et al. does not disclose a nonwoven web color-pigmented by one or more pigments mixed into the polymeric material. Noda et al. does not disclose a polymeric backsheet film color-pigmented by one or more pigments mixed into the polymeric material.

Additionally, although Noda et al. teaches an L\* value of the *printed area* of 10 to 93 (Noda et al., Col. 1, line 63; Col. 4, lines 30-34), it only teaches an L\* value *for a background* – *i.e.*, the non-printed area – of 96 (Noda et al., Col. 7, lines 48-51). Assuming *arguendo* (as the Office does), that this is a relevant comparison (*i.e.*, that a Hunter L value is equivalent to an L\* value of the same number), a Hunter L/L\* value of 96 is outside the range of Applicants' Claim 1. Analogizing the printed film discussed by Noda et al. to printed white paper, the L\* value of 10 to 93 would correspond to the printed areas of the paper, while the L\* value of 96 would correspond to the white paper itself, either before printing, or after printing but outside the printed areas. Applicants' Claim 1 requires a Hunter L value falling in the range 10 to 75, in the areas outside the printed ornamental designs.

Yeo et al., expressly concerned with formulation and printing for wearability, durability and colorfastness of ink-printing (Col. 2, lines 9-47), contains no teaching or suggestion concerning brightness or color scale values of the backsheet material on which printing is done. Thus, Yeo et al. does not teach or suggest the claim element missing from Noda et al.

Because the combination of Noda et al. and Yeo et al. does not teach or suggest all of the elements of Claims 1 and 2, the combination does not support a *prima facie* case of obviousness of these claims. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

Rejection under 35 USC §103(a) over Tao et al.  
in view of Rogers et al. and further in view of Yeo et al.

Claims 1 and 3-7 stand rejected under 35 USC §103(a) as being unpatentable over Tao et al., WO 99/32164 in view of Rogers et al., USPN 5,133,707, and further in view of Yeo et al., USPN 5,695,855. Applicants respectfully traverse the rejection.

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Without conceding the correctness of the rejection, Applicants have amended independent Claim 1. Amended Claim 1 recites a disposable article selected from baby diapers, pull-on diapers, pants or adult incontinence diapers comprising a liquid pervious topsheet, a liquid impervious backsheet and an absorbent core positioned between said topsheet and said backsheet, wherein said backsheet comprises at least one polymeric film and at least one nonwoven web, wherein said polymeric film and said nonwoven web each have two major surfaces, said polymeric film comprises a polymeric film material, and said nonwoven web comprises a polymeric nonwoven web material, wherein at least one of said polymeric film material or said polymeric nonwoven web material is color-pigmented by one or more pigments mixed thereinto prior to formation of said polymeric film or said nonwoven web, and wherein at least one of said polymeric film or said nonwoven web has visually discernible printed ornamental designs, said printed ornamental designs being provided by printing a pigmented ink onto at least one of said major surfaces of at least one of said polymeric film or said nonwoven web, and said polymeric film being joined in an overlaying region across at least part of one of its major surfaces to at least part of an adjacent major surface of said nonwoven web to form said backsheet, and wherein said backsheet in said overlaying region has an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an "a" value for red/green-appearance from about -50.0 to about +50.0 and a "b" value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed ornamental designs. By dependency, Claims 3-7 contain all of the elements of Claim 1.

Applicants respectfully submit that neither Tao et al. nor Rogers et al. nor Yeo et al, alone or in combination, teaches or suggests a disposable article as recited. Without waiving, and reserving, all other arguments Applicants may have, the references in combination do not disclose a backsheet comprising at least one polymeric film and at least one nonwoven web, wherein at least one of the polymeric film material or the polymeric nonwoven web material is color-pigmented by one or more pigments mixed thereinto prior to formation of said polymeric film or said nonwoven web, wherein the backsheet has an L Hunter value from 10 to 75, in the areas outside printed ornamental designs.

As noted by the Office at page 5 of the Office Action dated 4/23/08, the combination of Tao et al. and Rogers et al. does not disclose a nonwoven web color-pigmented by one or more pigments mixed into the polymeric material. The combination

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also does not disclose a polymeric backsheet film color-pigmented by one or more pigments mixed into the polymeric material. Yeo et al., expressly concerned with formulation and printing for wearability, durability and colorfastness of printed materials (Col. 2, lines 9-47), contains no teaching or suggestion concerning brightness or color scale values of backsheet materials – it does not disclose the elements missing from Tao et al. and Rogers et al. Thus, these references in combination do not teach or suggest all of the elements of Applicants' claims, and for that reason alone, do not support a *prima facie* case of obviousness.

The Office relies upon the teachings of Rogers et al. for the proposition that the L value of a material is result effective, making it obvious to modify this value to achieve improved obscuring effect. Thus, the Office contends, it would be obvious to modify the article taught by Tao et al. to fall within Applicants' claimed range of L values to improve obscuring effect. Applicants believe, and respectfully submit, that this reasoning contains errors.

To establish a *prima facie* case of obviousness, [the proponent] must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." [*In re Fine*, 837 F.2d at 1074, 5 U.S.P.Q.2D (BNA) at 1598. There is no suggestion to combine, however, if a reference teaches away from its combination with another source. *See id.* at 1075, 5 U.S.P.Q.2D (BNA) at 1599. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1131 (Fed. Cir. 1994). If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); *see also In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

*Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1353, 1359-1360; 52 U.S.P.Q.2d 1294 (Fed. Cir. 1999). Accordingly, a proposed modification to a first reference taught by a second reference cannot render the first reference unsatisfactory for its intended

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purpose, nor can it change the principle of operation of the first reference, and still be a *prima facie* basis for a conclusion of obviousness. *See* MPEP § 2143.01 V., VI.

Rogers et al. teaches that a lower L value corresponds to a darker color (Rogers et al., Col. 4, lines 37-38), and that raising the L value of an adherent surface (making it brighter) will increase an obscuring effect with respect to described embossed indicia on an overlaid fastening tape (Col. 4, lines 16-27). This is different from the purposes expressed in Applicants' specification ("to provide a light, thin and flexible absorbent article with an improved outer appearance without the need to employ economically unattractive materials" and "to provide multicolored absorbent articles, which are thin, light and highly flexible due to use of thin materials with low basis weight"). (Specification, p. 2, lines 8-13, and p. 3, lines 25-29). Rogers does not supplement the disclosure of Tao et al. to serve Applicants' purposes.

Moreover, one of the expressly stated objectives of Tao et al. is providing a high degree of whiteness of a disposable article, for purposes of consumer acceptance. (Tao et al., page 2, lines 23 – 35; *see also* example at pp. 12-13 – L value of 93.46.) It would be inconsistent with this objective to seek to manufacture a backsheet of a color having an L Hunter value within the lowered range of Applicants' claims (10 to 75).

Thus, no teaching, suggestion or motivation to look to the teachings of Rogers et al. as a reason to modify Tao et al., to produce a backsheet having a lowered L value, is demonstrated. Rather, Tao et al. teaches away from such a modification.

Because (1) the combination of Tao et al., Rogers et al. and Yeo et al. does not teach or suggest all of the claim elements of Claims 1 and 3-7, and (2) no teaching, suggestion or motivation to combine these references is demonstrated, the combination does not support a *prima facie* case of obviousness of these claims. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

#### Remaining Rejections – Claims 8 and 9

Claims 8 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Noda et al. in view of Yeo et al. and further in view of McFarland et al., USPN 6,096,412).

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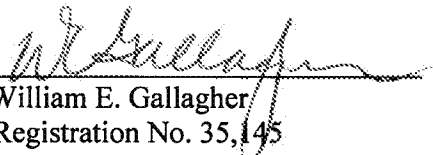
Without waiving, and reserving, all other arguments it may have, Applicants note that Claims 8 and 9 are dependent on Claim 1, and thus contain all the elements of Claim 1. As discussed above, Applicants submit that a *prima facie* case of obviousness of Claim 1 is not supported by the combination of Noda et al. and Yeo et al. McFarland et al. does not teach or suggest the missing elements. Accordingly, a *prima facie* case of obviousness is not established with respect to Claims 8 and 9. Applicants, therefore, respectfully request reconsideration and withdrawal of the rejection.

Conclusion

This response represents an earnest effort to place the present application in proper form for allowance. In view of the foregoing, entry of the amendment presented herein, reconsideration of this application, and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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